Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GILBERT W. YOUNGER

Appeal No. 2000-1743
Application No. 09/314,618

ON BRIEF

Before COHEN, FRANKFORT, and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 8. Claims 21 through 24, the only other claims remaining in the application, have been withdrawn from further consideration as being directed to a non-elected invention. Claims 9 through 20 have been canceled.

Appellant's invention relates to a method for modifying hydraulic circuitry of an automotive transmission (specifically a Hydramatic 4L80E General Motors transmission) so as to enable a user to select first gear at any time, thereby enabling the driver to obtain a "first" gear ratio whenever the gear selector lever is placed in the "1" position without regard to the actual vehicle speed or engine rotational speed. Independent claim 1 is representative of the subject matter on appeal and a copy of that claim can be found in the Appendix to appellant's brief.

The sole prior art reference relied upon by the examiner in rejecting the appealed claims is:

Bouda 4,858,498 Aug. 22, 1989

Claims 1 through 6 and 8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bouda.[1]

[1] In the advisory action mailed September 3, 1999 (Paper No. 6), the examiner has withdrawn the rejection of claim 7 under 35 U.S.C. § 102(b) based on Bouda and also the rejection of

As stated in the final rejection (Paper No. 3, mailed July 16, 1999) and the advisory action (Paper No. 6), claims 1 through 8 also stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of several different prior U.S. patents. See pages 6 through 8 of the final rejection for the details.[2]

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellant regarding the rejections, we make reference to the final rejection (Paper No. 3) and the examiner's answer (Paper No. 9, mailed December 30, 1999) for the reasoning in support of the rejections, and to appellant's brief (Paper No. 8, filed

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claims 1 through 8 under 35 U.S.C. § 112, second paragraph.

[2] While the examiner has not expressly repeated each of these rejections in the examiner's answer (Paper No. 9), it is clear from a review of the final rejection, appellant's brief (Paper No. 8) and the totality of the examiner's answer that the double patenting rejections based on the judicially created doctrine of obviousness-type double patenting are still valid rejections and, given appellant's Notice of Appeal, are before us in this appeal.

November 22, 1999) and reply brief (Paper No. 10, filed January 27, 2000) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art reference, and to the respective positions articulated by appellant and the examiner.[3] As a consequence of our review, we have made the determinations which follow.

Looking at pages 3, 4 and 6 of the brief, we note that appellant has indicated with regard to the rejections based on

[3] The record indicates that appellant filed new drawings (Figs. 1A-1D) on August 9, 1999 as an attachment to Paper No. 4. However, no such drawings are to be found in the file. Appellant and the examiner should resolve this problem during any further prosecution of the application. As a further point, we note that the examiner (in Paper No. 6) indicates that the new drawings were not approved, however, the examiner approved amendments to the specification contained in Paper No. 4 which specifically relate to new drawing Figures 1A-1D, thus creating an inconsistency between the specification and the single drawing figure originally filed with the application.

obviousness-type double patenting that a terminal disclaimer will be filed to obviate these rejections upon final disposition of the instant appeal. Given that no such terminal disclaimer has as of yet been filed by appellant and no argument made with respect to these grounds of rejection, and the fact that appellant has indicated that he "does not contest the obviousness-type double patenting rejections raised against claims 1-8 in the final action," we summarily sustain the examiner's rejections of claims 1 through 8 based on obviousness-type double patenting.

Regarding the examiner's rejection of claims 1 through 6 and 8 under 35 U.S.C. § 102(b) based on the Bouda patent, we note that claim 1 on appeal sets forth a method for modifying hydraulic circuitry of an automotive transmission comprising the step of

> providing a fluid flow path from said manual valve to a predetermined end of said "1 - 2" shift valve for applying a fluid pressure to said predetermined end of said "1 - 2" shift valve sufficient to maintain said "1 - 2" shift valve in a downshifted position whenever said gear selector is in a first gear position without regard to the actual speed of a vehicle in which said transmission is installed.

Claim 3 adds the limitation that the hydraulic circuitry includes means for urging the 1-2 shift valve into an upshifted position, and that the method includes

> applying said fluid pressure to said predetermined end of said 1 - 2 shift valve sufficient to overcome said means for urging said 1 - 2 shift valve into said upshifted position to maintain said 1 - 2 shift valve in said downshifted position when said gear selector is in said first gear position.

In the examiner's view (final rejection, page 5), Bouda discloses an automotive transmission that includes a manual valve (61) coupled to a gear selector and operatively associated with a 1-2 shift valve (63), "wherein a fluid flow path/passageway (102, 102a) is provided from the manual valve to a predetermined end (i.e., right-hand end in the drawings) of the 1-2 shift valve for applying a fluid pressure thereto sufficient to maintain . . . the 1-2 shift valve in a downshifted position (i.e., "1st FIX") without regard to vehicle speed when the gear selector is in a first gear position (1-range)." As for the means for urging the 1-2 shift valve into an upshifted position as set forth in claim 3, the examiner indicates that when the gear selector of Bouda is in the first gear position "the fluid pressure overcomes a

spring (no reference numeral) which is provided at an end of the 1-2 shift valve opposite the predetermined end for urging the 1-2 shift valve into an upshifted position."

Having carefully reviewed the disclosure of the Bouda patent and appellant's arguments in the brief and reply brief, we must agree with appellant that the Bouda patent does not anticipate the method as set forth in claims 1 through 8 on appeal. More particularly, we observe that the factual findings made by the examiner (as noted above) relative to the operation of the 1-2 shift valve of the transmission in the Bouda patent are incorrect. In discussing the "HYDRAULIC CONTROL CIRCUIT" in columns 3 and 4, the Bouda patent makes clear that port (a) of select valve (61) is communicated with the pressure line (101) from the pump (50) when the gear selector lever is in the "1" position and that port (a) is further connected to the line (111) which is branched at an end portion thereof into a first pilot line (102), a second pilot line (103) and a third pilot line (104). The Bouda patent goes on to indicate that

> [t]he line **102** is provided with a 1-2 shift solenoid valve **51** for controlling the operation of a 1-2 shift valve **63** and a flow restriction **86.** The line **103** is provided with a 2-3 shift solenoid valve **52** for controlling the operation of a 2-3 shift valve **64** and a flow restriction **87.** The line **104** is provided with a 3-4 shift solenoid valve **53** for controlling the operation of 3-4 valve **65** and a flow restriction **88.** The solenoid valves **51, 52** and **53** function to close drain lines **105, 106** and **107** for the lines **102, 103** and **104,** respectively, when energized to produce pilot pressures in the respective lines **102, 103,** and **104.** The pressures in the lines **102**, **103** and **104** function to move the shift valves **63, 64** and **65** from right positions to left positions to effect shift operations.

Comparing the above-noted disclosure of the Bouda patent with the factual findings made by the examiner reveals that Bouda does not disclose or teach a fluid flow path/passageway (111, 102, 102a) from the manual valve (select valve 61) to a predetermined end (i.e., right-hand end in the drawings) of the 1-2 shift valve (63) "for applying a fluid pressure thereto sufficient to maintain . . . the 1-2 shift valve in a downshifted position (i.e., "1st FIX") without regard to vehicle speed when the gear selector is in a first gear position (1-range)," as urged by the examiner. To the contrary, it is clear from the disclosure noted above in the

Bouda patent that the 1-2 shift valve (63) is maintained in a downshifted position (1st gear) when there is little or no fluid pressure being applied to line (102a) or to the right-hand end of the valve as seen in Figure 1B (i.e., when the solenoid valve 51 is deenergized and the fluid exits at drain line 105). When the solenoid valve (51) is energized it closes drain line (105) and produces pilot pressure in the line (102, 102a) to move the shift valve (63) from its right position to its left position to thereby effect shift operations (i.e., to allow an upshift of the transmission from 1st gear to 2nd gear). In this regard, the method as disclosed in Bouda is completely different than that set forth in appellant's claim 1 on appeal.

As for the means for urging the 1-2 shift valve into an upshifted position as set forth in appellant's claim 3 and the method step therein, we again note that the operation of the transmission in Bouda regarding the 1-2 shift valve is entirely different than that required in appellant's claim 3 on appeal. See pages 3-5 of appellant's reply brief for the detailed reasoning. For similar reasons, we also agree with

appellant's position (reply brief, pages 5-9) regarding dependent claims 5, 6 and 8 on appeal.

In view of the foregoing, the examiner's rejection of claims 1 through 6 and 8 under 35 U.S.C. § 102(b) will not be sustained.

To summarize: the examiner's decision rejecting claims 1 through 6 and 8 of the present application under 35 U.S.C. § 102(b) is reversed; however, the decision to reject claims 1 through 8 under the judicially created doctrine of obviousness-type double patenting is affirmed. Since at least one rejection of each of the claims on appeal has been affirmed, the decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

IRWIN CHARLES COHEN Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)

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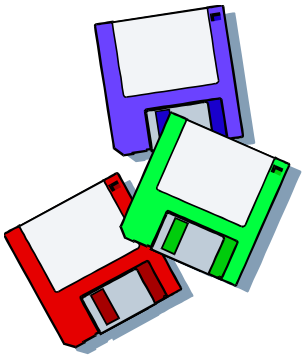

Lesley

Appeal No. 2000-1743
Application No. 09/314,618

APJ FRANKFORT

APJ STAAB

APJ COHEN

DECISION: AFFIRMED

Prepared: June 27, 2002

Draft Final

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